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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/854,334

05/11/2001

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007287.00035

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22907 7590 08/01/2008

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EXAMINER

NGUYEN BA, HOANG VU A

ART UNIT

PAPER NUMBER

2623

MAIL DATE

DELIVERY MODE

08/01/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/854,334	Applicant(s) KIKINIS ET AL.	
	Examiner Hoang-Vu A. Nguyen-Ba	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-16, 18-31, 33 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-16, 18-31 and 33-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 7, 2008 has been entered.
2. Claims 1-5, 7-16, 18-31 and 33-34 remain pending. Claims 1, 12 and 23 are independent claims.

Response to Amendments

3. Per Applicants' request, Claims 1, 4, 5, 8, 10, 12, 15, 19, 21, 23, 29 and 31 have been amended.

Response to Arguments

4. Applicants' arguments in the Remarks section of the amendment have been fully considered but are not persuasive. The following is an examiner's response to Applicants' arguments.

Claims 1, 12 and 23

Applicants' arguments:

Amended independent claim 1 relates to, inter alia, memory configured to store a first object and a second object, the second object configured to define an interactive component for display in an interactive electronic programming guide (EPG), wherein the interactive component includes localized content; and a processor configured to generate the interactive EPG by combining the first and second objects, wherein a layout of the interactive EPG including a display position of the interactive component in the interactive EPG is defined by the first object. Martino fails to teach or suggest such features. Martino describes the use of different worlds for different functions such as a search world, a profiling world and an overview world. Col. 2, 11. 21-22. Nonetheless, Martino does not teach or suggest a second object defining an interactive component having localized content and generating an EPG by combining the second object with a first object defining a layout of the EPG including a position of the interactive component. The Office Action asserts, at p. 4, that the claimed second object is interpreted as being the software module to display the search world or the profile world and that the first object corresponds to beads. Even assuming, without conceding, that such a comparison is valid, neither the search world nor the profile world constitutes an electronic programming guide. Moreover, Martino's

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bead (i.e., the alleged first object) does not define the layout of an EPG, much less the position of the interactive component defined by the second object. Accordingly, claim 1 is allowable for at least these reasons.

Examiner's response:

In response to Applicants' assertion that Martino does not teach or suggest a second object defining an interactive component having localized content, the examiner respectfully notes that the claimed localized content is deemed inherent to Martino because a user in San Francisco, CA may not receive the same television programs as one in Alexandria, VA notwithstanding they are affiliated to the same television network, e.g., CBS in FIG. 8. Furthermore, in 3:16-51, the described MbTV is shown to provide recommended television programs based on viewer's preferences. Since MbTV is well known in the art to be a product that also provides targeted advertising (see Metabyte to demonstrate MbTV at the Western Cable Show, Business Wire, December 13, 1999, http://findarticles.com/p/articles/mi_m0EIN/is_1999_Dec_13/ai_58174989), which is localized content, Martino is considered to teach or at least suggest the localized content because it would make sense that a viewer in the West Coast would most likely prefer to view the television programs of his/her local viewing area rather than those broadcast on the East Coast.

With respect to Applicants' assertion that Martino does not teach generating an EPG by combining a second object with a first object that defines a layout of the EPG including a position of the interactive component, the examiner notes that the claimed first object defining a layout of the EPG including a position of the interactive is nowhere clearly described or at least suggested in Applicants' disclosure. Furthermore, the examiner submits that Martino's software module does define the position of the interactive component because without specifying a position on the screen the Search bin (i.e., an interactive component) would not be displayed where it is shown in FIG. 6, at least.

With respect to Applicants' argument that Martino fails to teach or suggest either the search world or the profile world that constitutes an electronic programming guide, the examiner respectfully disagrees with this assertion because as clearly shown at least

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in FIG. 8, the information such as channel, genre, show title, show time are well-known in the art information pertaining to EPG.

With respect to Applicants' argument that Martino's beads does not define the layout of an EPG, much less the position of the interactive component defined by the second object, the examiner notes the following: first the claimed first object is equated with Martino's preferred user interface (UI); second, the claimed "second object" is equated with Martino's application software to display the relevant information in three-dimensional view, e.g., instructions on where to display the beads, strings and bins, which are interactive components, in the interface.

Claims 2-5, 8-9, 11, 13-16, 22 and 24-27

Applicants' arguments

Claims 2-5, 8, 9, 11, 13-16, 22 and 24-27 are dependent on claims 1, 12 and 23, respectively, and are thus allowable for at least the same reasons as their base independent claim and further in view of the novel and non-obvious features recited therein.

Examiner's response

For the features recited in each of these dependent claims, see Office action.

Claim 8

Applicants' arguments

For example, claim 8 recites, inter alia, "first object is selected from a plurality of world objects based on a selected type of programming, wherein each of the plurality of world objects defines a different EPG layout." Martino does not teach or suggest such a feature. Again, Martino is limited to three worlds: a profiling world, a search world and an overview world. As discussed above, neither the profiling world nor the search world constitute EPGs and thus, do not each define a different EPG layout (in fact, they do not define EPG layouts at all). Further, even assuming that the profiling world, the search world and the overview world define different EPG layout, a world is not selected based on a selected type of programming. Martino describes triggering actions based on a context in which a button is pressed. Col. 7, 11. 58-60. However, nowhere does Martino teach or suggest that the context corresponds to a selected type of programming or that the triggered action is a first object selected from a plurality of world objects. Accordingly, claim 8 is allowable for this additional reason.

Examiner's response

Claimed features	Equivalent features in Martino
first object	User interface (UI)

Selected from a plurality of world objects	three environments or worlds (2:21-22)
Based on a selected type of programming	type of programming with search or profile or overview
Wherein each of the plurality of world objects defines a different EPG layout	Figs. 6-8 all show EPG information (e.g., show title, show time); if search world is selected, the layout shown in FIG. 6 is displayed, if overview is selected, layout shown in FIG. 8 is displayed

Claim Rejections under 35 U.S.C. § 103(a)

Applicants' arguments

Claims 7, 10, 18, 19, 21, 22 and 28-34 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Martino in view of Finseth et al. (U.S. Patent No. 6, 754,906, hereinafter "Finseth"). This rejection is respectfully traversed for at least the following reasons. Claims 7, 10, 18, 19, 21, 22, 28-31, 33 and 34 depend on claims 1, 12 and 23, respectively, and thus incorporate all of the features of their respective base independent claims. As discussed above, Martino fails to teach or suggest each and every feature of claims 1, 12 and 23. Finseth does not cure the above-identified deficiencies of Martino. Accordingly, notwithstanding the validity of the asserted combination of Martino and Finseth, the asserted combination would not have resulted in the features of claims 1, 12 and 23, upon which claims 7, 10, 18, 19, 21, 22, 28-31, 33 and 34 depend. Accordingly, claims 7, 10, 18, 19, 21, 22, 28-31, 33 and 34 are allowable for at least these reasons.

Examiner's response

Since Claims 7, 10, 18, 19, 21, 22 and 28-34 incorporate the features of the respective base claim, the same response discussed in conjunction with the base claims is thus applicable to these claims.

Applicants' arguments

Additionally, Applicants note that the fact that a certain result or characteristics may occur or be present in the prior art is NOT sufficient to establish the inherency of that result or characteristics. MPEP § 2112(IV) (citing *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993) (emphasis added). Indeed, to establish inherency, "the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" *In re Robertson*, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999) (Emphasis added). The Office Action uses inherency in the rejections of claims 1, 10, 21 and 33, without providing any explanation or support as to why the features recited in those claims would be necessary in either Martino or Finseth.

Examiner's response

As best surmised by the examiner, the alleged missing descriptive matter that is NOT necessarily present in the thing described in the reference is the "localized content." For a discussion related to the localized content, Applicants' attention is respectfully directed to the first paragraph of the examiner's response to Applicants' arguments with respect to Claims 1, 12 and 23.

According to the foregoing discussion, the rejection of Claims 1-5, 7-16, 18-31 and 33-34 are maintained.

Claim Objection

5. Claims 1, 12 and 23 are objected to because of the following minor informalities:

Applicants introduced the following limitation "including a display position of the interactive component in the interactive EPG" into Claims 1, 12 and 23. It is unclear as to the meaning and scope of this limitation. It is unclear whether the claimed "display position" is intended to mean the "displayed position" or "position of the display" or the "coordinates" of the interactive component. Furthermore, the claimed limitation does not appear to be anywhere described in the original disclosure.

For compact prosecution purposes, the claimed "display position of the interactive component in the interactive EPG" is interpreted as the position of the second object which is considered to be anticipated by Martino in 2:35-39 -- e.g., information on how to spatially arrange on the display the interactive component such as search world or profile word taught in Martino.

Appropriate correction is required.

Claim Rejections – 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejection under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-5, 8-9, 11-16, 20 and 22-27 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,662,177 to Martino et al. (“Martino”).

Claim 1

Martino discloses *a system, comprising:*

a memory (see at least FIG. 1, memory inside the computer 240) storing a first object (see at least 4:31-45) and a second object, the second object configured to define an interactive component for display in an interactive electronic programming guide (EPG), wherein the interactive component includes localized content (see at least 2:6 – 4:30; e.g., the claimed second object is interpreted as being the software module to display the search world or the profile world); and

a processor (see at least FIG. 1, CPU inside the computer 240) configured to generate the interactive EPG by combining the first and second objects (see at least FIGs. 14-17), wherein a layout of the interactive EPG including a display position of the interactive component in the interactive EPG is defined by the first object (see at least 2:35-39).

It is noted that the feature “localized content” is deemed inherent to Martino because a user in San Francisco, CA may not receive the same television programs as one in Alexandria, VA notwithstanding they are affiliated to the same television network, e.g., CBS in FIG. 8.

Claim 12

Claim 12 is a method claim that corresponds to Claim 1. Therefore, Claim 12 is rejected for the same reasons as discussed in Claim 1.

Claim 23

Claim 12 is an apparatus claim (i.e., *a machine-readable storage medium tangibly embodying a sequence of instructions executable by a processor*) that corresponds to Claim 1. Therefore, Claim 23 is rejected for the same reasons as discussed in Claim 1.

Claims 2, 14 and 24

Rejections of base claims 1, 12 and 23, respectively are incorporated. Martino further discloses *wherein the system comprises a set-top box, a television, or a VCR* (see at least FIG. 1, devices 230, 240; 9:14-15).

Claims 3 and 25

Rejections of base claims 1 and 23, respectively are incorporated. Martino further discloses *wherein the system includes a plurality of drivers, one of the drivers communicating with a separate unit to replenish programming information* (see at least 6:50 – 7:54).

Claims 4, 13, 15 and 26

Rejections of base claims 1, 12 and 23, respectively are incorporated. Martino further discloses *wherein the memory further stores a third object corresponding to content information to be displayed in the EPG, and wherein the processor is configured to generate the interactive EPG by further combining the first and second objects with the third object* (see at least 2:21-29; the claimed third object is being interpreted as the software module to display the overview world), *wherein the first object further defines a position of the content information to be displayed in the interactive EPG* (see at least 2:35-39).

Claims 5, 16 and 27

Rejections of base claims 1, 12 & 23 and intervening claims 4; 13, 14 & 24, 26, respectively are incorporated. Martino further discloses *wherein the third object includes at least one of a schedule times, channel identification and a title* (see at least FIGs. 4-17, wherein in FIG. 4, e.g., Day, Time, Channel, Keyword).

Claim 8

The rejection of base claim 1 is incorporated. Martino further discloses wherein the first object is selected from a plurality of world objects based on a selected type of programming, wherein each of the plurality of world objects defines a different EPG layout (see at least 2:21 – 3:14; 7:55-65; note that the claimed “selected type of programming” is equated with Martino’s search, profile or overview and the claimed “different EPG layout” is equated with the different types of EPG layout shown respectively in FIG. 6 – EPG with Search, FIG. 7 – EPG with Profile, and FIG. 8 – EPG with Overview).

Claim 9

Rejections of base claim 1 and intervening claim 8 are incorporated. Martino further discloses *wherein the first object defines a virtual world and a subset of the virtual world is displayed as a matrix of rectangular boxes containing current program information* (see at least FIG. 10).

Claim 11

The rejections of base claim 1 is incorporated. Martino further discloses *a user interface configured to receive user interaction with the localized content of the interactive EPG* (see at least 2:21 – 3:15).

Claim 20

The rejection of base claim 12 is incorporated. Martino further discloses *wherein the first object defines a virtual world and wherein a subset of the virtual world is displayed as a matrix of rectangular boxes containing current program information* (see at least FIG. 10).

Claim 22

The rejection of base claim 12 is incorporated. Martino further discloses *further comprising generating a user interface coupled to the EPG and configured to receive user interaction with the localized interactive component* (see at least 2:21 – 3:15).

Claim Rejections – 35 USC § 103

8. The following is a quotation of the 35 U.S.C. § 103(a) which form the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 7, 10, 18-19, 21-22 and 28-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Martino, as applied to the corresponding base and intervening claims, in view of U.S. Patent No. 6,754,906 to Finseth et al. (“Finseth”).

Claim 7

The rejections of base claim 1 and intervening claim 4 are incorporated. Martino does not specifically disclose *wherein the second object is configured to provide non-EPG e-commerce interactivity*. However, in an analogous art, Finseth teaches displaying a Main Menu, which provides a user interface for purchasing items through an electronic catalog (see at least FIG. 9). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Finseth with Martino. One of ordinary skill in the art would have been motivated to implement such a combination for the sake of providing user with e-commerce capabilities to Martino.

Claim 10

The rejections of base claim 1 and intervening claims 4 & 7 are incorporated. Martino does not specifically disclose *wherein the second object is received in real time*. However, this

feature is deemed inherent to Finseth because the electronic catalog (see at least 20:27-29) disclosed in Finseth should be updated in real-time to reflect the inventory of items in stock so that when a user searches the electronic catalog for an purchasing item and /or places an order, the item(s) is/are available or shown to be available in the near future. Without the real-time operating capability, e-commerce would be inefficient and the sales company would lose credibility and business very quickly.

Claims 18 and 28

Pursuant to Claim 18, the rejection of base claim 12 is incorporated.

Pursuant to Claim 28, the rejection of base claim 23 is incorporated.

Martino does not specifically disclose *wherein the second object is a non-EPG e-commerce objects*. However, in an analogous art, Finseth teaches software module to display a Main Menu, which provides a user interface for purchasing items through an electronic catalog (see at least FIG. 9). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine Finseth with Martino. One of ordinary skill in the art would have been motivated to implement such a combination for the sake of providing user with e-commerce capabilities to Martino.

Claims 19 and 29

Rejections of base claims 12 & 23 and intervening claims 13-18 & 24-28 are respectively incorporated. Martino further discloses *wherein the first object is selected from a plurality of world objects based on selected programming content* (2:21 – 3:14; 5:22-43; 7:55-65; see note in Claim 8).

Claim 30

The rejection of base claim 23 and intervening claims 24, 26-29 are incorporated. Martino further discloses *wherein the first object defines a virtual world and wherein a subset of the virtual world is displayed as a matrix of rectangular boxes containing current program information* (see at least FIG. 10).

Claims 21 and 33

Pursuant to Claim 21, rejections of base claim 12 and intervening claim 18 are incorporated.

Pursuant to Claim 33, the rejection of base claim 23 is incorporated.

Martino does not specifically disclose *receiving the second object in real time*. However, this feature is deemed inherent to Finseth because the electronic catalog (see at least 20:27-29) disclosed in Finseth should be updated in real-time to reflect the inventory of items in stock so that when a user places an order, the item(s) is/are available or shown to be available in the near future. Without the real-time operating capability, e-commerce would be inefficient and the sales company would lose credibility and business very quickly.

Claim 34

The rejections of base claim 23 and intervening claim 33 are incorporated. Martino further discloses *further comprising generating a user interface coupled to the EPG and configured to receive user interaction with the localized interactive component* (see at least 2:21 – 3:15).

Claim 31

Rejections of base claim 23 and intervening claims 24, 26-30 are incorporated. Martino further discloses *wherein the first object is user-selected from a plurality of world objects, each of the plurality of world objects defining a different layout for displaying the programming information* (see at least 2:21 – 3:15, 5:22-43, 7:55-65; note that the claimed “different EPG layout” is equated with the different types of EPG layout shown respectively in FIG. 6 – EPG with Search, FIG. 7 – EPG with Profile, and FIG. 8 -- EPG).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu “Antony” Nguyen-Ba whose telephone number is

(571) 272-3701. The examiner can normally be reached on Tuesday-Friday from 7:00 am to 5:30 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2600 Group receptionist (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Hoang-Vu Antony Nguyen-Ba/
Primary Examiner, Art Unit 2623
July 30, 2008